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422541—41

In the Supreme Court of the United States

OCTOBER TERM, 1941

No. 661

AMERICAN TRI-ERGON CORPORATION AND TRI-ERGON HOLDING A. G., PETITIONERS

v.

RADTKE PATENTS CORPORATION AND ALBERT A. RADTKE, WHITSON PHOTOPHONE CORPORATION AND DELMAR A. WHITSON, CONWAY P. COE, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF FOR RESPONDENT COMMISSIONER OF PATENTS IN OPPOSITION

OPINIONS BELOW

The memorandum opinion of the District Court of the United States for the District of Columbia (R. 1510) is reported in 30 F. Supp. 83. The opinion of the United States Court of Appeals

for the District of Columbia (R. 2056–2080) is not yet officially reported.

JURISDICTION

The judgment of the United States Court of Appeals for the District of Columbia was entered on June 30, 1941 (R. 2081). A motion for rehearing was denied on August 29, 1941 (R. 2094). The petition for writ of certiorari was filed on September 27, 1941. The jurisdiction of this Court is invoked under section 240 (a) of the Judicial Code as amended by the Act of February 13, 1925.

QUESTIONS PRESENTED

1. Whether, in a proceeding brought pursuant to R. S. 4915 to obtain the issuance of a patent, where the question of invention was neither framed by the pleadings nor put in issue before the district court, an appellate court may consider the question and, on the ground that the claims fail to describe a patentable invention, direct a dismissal of the complaint.

2. Whether the record supports the conclusion of the court below that, as determined by the Patent Office in 1927, the claims in suit are unpatentable because lacking in invention.

STATUTE INVOLVED

Revised Statutes, sec. 4915, as amended by the Act of March 2, 1927, sec. 11, 44 Stat. 1335, and

Act of March 2, 1929, sec. 2 (b), 45 Stat. 1475 (35 U. S. C. 63):

> Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the board of appeals to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party, a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and con-

ditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

STATEMENT

The petitioners are the assignees of all rights to and under a patent application which was filed in the Patent Office on April 4, 1921, by Vogt and others. The application (R. 1557–1563) deals with a sound-reproducing apparatus whereby light is passed through a film on which sound has been recorded, causing acoustically modulated light to strike a photoelectric cell having an alkali cathode, setting up a correspondingly modulated current. In July 1927 the Board of Appeals of the Patent Office sustained a final rejection of the claims on the ground that no invention was involved (R. 1619–1622). Thereafter, American Tri-Ergon Corporation (hereinafter referred to as the petitioner) and others filed suit against the Commissioner of Patents under section 4915 of the Revised Statutes. The district court (Adkins, J.) held that the claims were patentable and entered a decree authorizing the Commissioner to issue the patent (R. 1625–1626). The Commissioner took

no appeal from the judgment, but in view of the holding that the subject matter was patentable, declared an interference among petitioner and the respondents Radtke and Whitson, who were applicants for patents on the same subject matter (R. 1626–1628). In the interference the Patent Office awarded priority to Radtke (R. 1963–1998), and on April 19, 1938, a patent was issued on his application (R. 1798).

Petitioners then filed the instant suit under R. S. 4915 to obtain a decree declaring that Vogt and others were the original inventors and authorizing and directing the Commissioner to issue a patent to petitioner (R. 2–16). The question of patentability was not drawn in issue by the pleadings and was not litigated. Finding no clear error in the decision of Justice Adkins (R. 1517), the district court (Goldsborough, J.) held that Vogt was entitled to priority over Radtke and Whitson and rendered a judgment authorizing the issuance of a patent to petitioner (R. 1526). In so doing it concluded that the claims define a "meritorious invention" (R. 1526), but apparently based that conclusion on the decision of Justice Adkins rather than on any independent determination of its own.

On appeal by Radtke and Whitson, the court below held that the question whether the claims disclosed invention must first be decided (R. 2058–2059). Concluding that in view of the prior art the claims lacked invention (R. 2077) and that

none of the parties was entitled to the monopoly desired (R. 2078), the court found it unnecessary to decide the question of priority (R. 2077–2078). It reversed the judgment of the district court and remanded the cause with instructions to dismiss the complaint (R. 2078). Justice Stephens dissented (R. 2078–2080).

ARGUMENT

The decision of Justice Adkins in 1931, while possibly *res judicata* as between the petitioner and the Commissioner of Patents, is not binding on the other respondents and the issue of patentability, therefore, may be determined in the present proceedings if properly raised. The petitioners do not contend otherwise. The questions involved are first, whether the court below had power to pass upon the question of patentability when the issue had not been framed by the pleadings of the parties or been litigated in the district court, and, second, whether the court below properly determined that the claims disclosed no invention. On both questions, we submit, the judgment below was correct.

1. As the court below held, the decision of this Court in *Hill* v. *Wooster,* 132 U. S. 693, controls as to the jurisdiction of an appellate court to pass upon the question of patentability on its own motion. In that case, which arose out of an interference proceeding involving two rival applicants

for patent on the same subject matter, both parties contended that invention existed, and they had apparently convinced the Commisisoner of Patents to that effect. At the trial no question as to invention was raised nor was evidence specifically introduced to show that there was invention. The trial court decided the case solely on the issue of priority. This Court, however, held that on appeal a court had not only the right but the duty to pass upon the question of invention before authorizing the issuance of a patent in a proceeding commenced under R. S. 4915. It found that the record before it disclosed lack of invention and directed the entry of a judgment in accordance with such conclusion. The facts in that case are strikingly similar to those here involved. Both cases arose out of an interference proceeding and the issue of patentability was not litigated.

Petitioners (Pet. 26) attempt to distinguish the decision in *Hill* v. *Wooster* on the ground that the Commissioner of Patents was not there a party, whereas he is a party in the instant suit and has not contested the patentability of the claims. They imply that the duty devolves upon him rather than upon the court to protect public interests against the grant of a monopoly where no true invention exists. That argument, however, overlooks the position of the Commissioner in the instant suit, and is, in any event, unsound. As the result of the decision of Justice Adkins in 1931,

the ruling of the Patent Office that the claims lacked invention was overruled. The Commissioner was not required to appeal from that judgment and his failure to do so no more relieved the courts of their duty to pass upon the question of patentability than did the failure of the Commissioner in *Hill* v. *Wooster* to find originally or to appear and urge later in the courts that the claims were unpatentable. There is nothing in the record to show that the Commissioner in the instant suit failed to contest the patentability of the claims for any reason other than that, as prior thereto in the interference proceeding, he considered himself bound by the 1931 decision. Accordingly, the wisdom of the rule requiring an appellate court to scrutinize the question of invention in a proceeding under R. S. 4915, even though such question is ignored by the parties, seems peculiarly evident in the instant case.[1]

2. The decision below on the question of patentability is correct and since it is not in conflict with that of any other court, except the district court, it presents no question for review. *Keller* v. *Adams-Campbell Co.,* 264 U. S. 314, 319–320; *Layne &c. Co.* v. *Western Well Works,* 261

[1] It may be noted that the court below was prompted to proceed as it did through the efforts of an amicus curiae (R. 2058). The applicants who were parties to the suit were interested in obtaining the patent for themselves and obviously were not seeking a holding that no invention was involved.

U. S. 387, 393; *General Pictures Co.* v. *Electric Co.,* 304 U. S. 175, 178–179. As the court below said (R. 2059), the determination of the Patent Office in 1927 that no invention was disclosed should be followed if "there is found to be a rational basis for the conclusions approved by the administrative body." *Mississippi Valley Barge Line Co.* v. *United States,* 292 U. S. 282, 286–287; *Rochester Tel. Corp.* v. *United States,* 307 U. S. 125, 146. The petitioners do not challenge, but apparently agree (Pet. 11, 19–20) that such is the proper scope of judicial review. The question whether the court below adopted the proper test to be applied upon review of a Patent Office determination is thus not presented.

Petitioners contend, however, that the court below was unjustified in not following the "final" rulings of the Patent Office and the findings of the district court in this case and in the 1931 proceedings (Pet. 19–21). The "final" rulings referred to are the declaration of an interference and an award of priority to Radtke. But, while ordinarily such a declaration involves a determination of patentability, in this case the interference was declared only after the 1931 judgment and in the view that the Patent Office was bound thereby. The district court in this case made no independent determinations of the facts on the issue of invention,[2] and, in-

[2] A remand to allow the district court to make such findings is not required under the rule of *Hill* v. *Wooster*, as is

sofar as the findings of Justice Adkins in 1931 called for application of the rule as to the scope of review of trial court findings, the court below correctly applied it (R. 2061–2078).

As the opinion of the court below fully discloses, there was ample evidence in the present record to support the finding of the Patent Office in 1927 (R. 1615–1622) that Vogt's disclosure of the use of a photoelectric cell in the reproduction of sound and as an efficient substitute for the selenium cell had been known to the art prior to Vogt's application (R. 2063, 2068, 2070). The petitioners' suggestion (Pet. 16–18) that the inference of no invention may not be drawn in the absence of supporting testimony of any expert witness is without substance. The inference may be drawn by the Patent Office and, in the absence of an administrative decision, by the court, as was done in *Hill* v. *Wooster, supra.* Manifestly, the court is not required to depend on the production of "expert" witnesses by applicants who are interested in sustaining patentability or by the Commisisoner who may not be a party.[3] Nor is it required to look solely to the testimony of those who are produced.

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clear from the decision there. Moreover, since the record plainly discloses a rational basis for the 1927 decision of the Patent Office (see *infra*, p. 11), the district court would be required to find nonpatentability as a matter of law.

[3] The Commissioner is not a necessary party and may not be joined at all where, as in most cases, the action is instituted outside the District of Columbia. Cf. *Jax Ice & Cold*

Petitioners complain that the court below took judicial notice of evidence not in the record. Whether the court erred in so doing need not be considered. For it is clear that, even if such evidence had been disregarded, the court would have been bound by the record evidence to find that there was no invention as determined by the Patent Office in 1927.[4]

Storage Company v. *Coe*, 118 F. (2d) 12 (App. D. C.), certiorari denied, No. 823, October Term, 1940; *Eno Limited* v. *Coe*, 106 F. (2d) 858 (App. D. C.).

[4] Petitioners state (Pet., p. 6) that the following references, not a part of the record, were relied upon by the court below: (1) *Walker* and *Lance*, "Photoelectric Cell Applications" (2d ed. 1935); (2) *Allen*, "Photoelectricity" (1913); (3) *Hughes* and *DuBridge*, "Photoelectric Phenomena" (1932); (4) *Zworykin* and *Wilson*, "Photocells" (2d ed. 1934); (5) Henney, "Electron Tubes in Industry" (1934); and (6) *Millikan*, "A Direct Photoelectric Determination of Planck's 'h'", 7 Phys. Rev. 355 (1916). These references were used by the court to support its conclusion that photoelectric cells were well known prior to 1919 (R. 2063). The court, however, found ample support in the record for this conclusion. 14 Bureau of Standards Bulletin 507 (1918); Testimony of Enge (R. 2065); Testimony of Bullard, Vogt's witness; Testimony of Radtke's and Whitson's witnesses (R. 2066). The other references to which the petitioners except, namely the Langmuir patent, the World patent, and the Kuntz Article (Pet., p. 6) were cited to demonstrate that successful experiments had been made to amplify currents from a photoelectric cell (R. 2070). But to support this conclusion the court relied primarily upon the Bergwitz Article and the Bureau of Standards Bulletin (R. 2070), which were in the record, as well as upon the testimony of expert witnesses (R. 2071).

CONCLUSION

For the reasons above stated, it is respectfully submitted that the petition for a writ of certiorari should be denied.

CHARLES FAHY,
Acting Solicitor General.
FRANCIS M. SHEA,
Assistant Attorney General.
MELVIN H. SIEGEL,
PAUL A. SWEENEY,
Attorneys.

W. W. COCHRAN,
Solicitor for the Patent Office.

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